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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,244	12/19/2000	Elizabeth Goldwyn Gibson	1906P	8208

7590 12/15/2006
SAWYER LAW GROUP LLP
PO Box 51418
Palo Alto, CA 94303

EXAMINER	
ELAHEE, MD S	
ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,244

Applicant(s)

GIBSON ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution-New ground of Rejection After Appeal

1. In view of the appeal Brief filed on 07/28/2004, PROSECUTION IS HEREBY REOPENED. The rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 5, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear and confusing as to what is the claimed "the telephone provides a three-way call" (e.g., see claim 1, lines 5-6). According to the specification (page 4, lines 14-18), it teaches "the telephone 100 performs a flash-hook (i.e., going off hook), which initiates 3-way call through line 102 of the voice mailbox 4".....when the voice mailbox 4" picks up again, the telephone joins the 3 parties.....". The so called "3-way" call initiated by the telephone 100 is not a 3-way call; it is just an ordinary call from called party's phone to the voicemail system. Such call enables the called party's phone to have a call connection to the switch or the voice mail system. Note, when the telephone 100 tries to make a connection to the switch or the voicemail system, the incoming call from the caller has been routed to the voicemail system. Further, the specification fails to disclose any structure in the called party's phone to perform call bridging feature. It is obvious that it is the switch 3" in Fig.3 provides or bridges the caller's call and the called party's call for forming 3-way calls.

Thus, the claims miss characterizes the invention; the called party's phone does not provide a 3-way call; the called party's telephone just have a call connection to the voicemail system or the switch and that connection is bridged to the caller's talk path.

4. Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the phrase 'the telephone' on lines 3,4 of the claim lacks sufficient antecedent basis because it appears that the phrase 'the telephone' should be 'a telephone'.

Claim 8 is rejected for the same reasons as discussed above with respect to claim 5.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Cannon for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Cannon for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-14 are rejected as best understood in light of the 35 U.S.C. 112, first paragraph rejection under 35 U.S.C. 102(e) as being anticipated by **Cannon** et al. (U.S. Patent 6,639,972).

Regarding claims 1 and 11, **Cannon** teaches a telephone system has
a switching system for receiving a call from a calling party (col.1, lines 33-41) and
a voice mail system [i.e., voice mailbox] coupled to the switching system for receiving
the call if a subscriber[i.e., called party] does not answer the call (fig.1, step 12; col.1, lines 33-41).

Further, **Cannon** teaches a telephone for receiving the call from the calling party (col.1, lines 33-41), by leaving the called party's telephone handset going off-hook and joins the caller's talk path (col.5, lines 8-10, 18-22), teaching of **Cannon** reads on the claimed "provides a three-way call between the calling party, the called party, and the voice mailbox". It is because, the examiner interprets this limitation as providing call connection from the called party to the voice

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mailbox and that call connection is bridged to the calling party's call by forming a 3-way call and **Cannon** teaches such feature on col.5, lines 8-10, 18-22.

Cannon further teaches that the called party's telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox (fig.1, step 17, fig.2, step 45).

Regarding claims 2 and 12, **Cannon** teaches that the telephone further comprises first and second connections to the switching system, wherein one of the first and second connections is utilized to provide a the three-way call (col.1, lines 33-41, col.4, lines 58-67, col.5, lines 8-10, 18-22).

Regarding claims 3, 6, 9 and 13, **Cannon** teaches that the calling party inherently cannot hear the called party during the three-way call (col.4, lines 58-67, col.5, lines 8-10, 18-22).

Regarding claims 4, 7, 10 and 14, **Cannon** teaches that the called party can, through interaction with the telephone, talk with the calling party through the other of the connections and the voice mailbox is dropped from the call (col.2, lines 53-63).

Claims 5 and 8 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, **Cannon** teaches receiving a call from a calling party by a voice mailbox (col.1, lines 33-41).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fobert et al: (U.S. 6,853,713) teach Client-server network for managing internet protocol voice packets.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

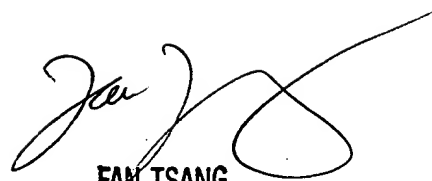
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ME

MD SHAFIUL ALAM ELAHEE

December 11, 2006

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a large, stylized loop at the end.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600